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EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,177

Applicant(s)

TANNENBAUM, MARY C.

Examiner

Ming Chow

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-18-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections

1. Claims 2, 34, 37 recite "the part of a message recipient". There is insufficient antecedent basis for this limitation in the claim.
2. Claim 8 recites "the play of messages". There is insufficient antecedent basis for this limitation in the claim. Claim 1 claims "playing each received message". Claim 1 did not claim play of a plurality of messages.
3. Claim 9 recites "said other messages". There is insufficient antecedent basis for this limitation in the claim. Claim 1 claims "playing each received message". Claim 1 did not claim play of a plurality of messages.
4. Claims 10, 11 recite "said selected other message". There is insufficient antecedent basis for this limitation in the claim. Claim 1 claims "playing each received message".
5. Claim 15 recites "said clock time". There is insufficient antecedent basis for this limitation in the claim.
6. Claim 21 recites "the corresponding provided message time". There is insufficient antecedent basis for this limitation in the claim.

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7. Claims 23, 25 recite "the identity". There is insufficient antecedent basis for this limitation in the claim.

8. Claim 28 recites "the receipt", "the interaction", "the playback". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 37 recites "the addition", "the time said message is played". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 38 recites "the time of said message storage". There is insufficient antecedent basis for this limitation in the claim.

11. Claim 39 recites "said associated playing time". There is insufficient antecedent basis for this limitation in the claim.

12. Claims 45, 46 recite "said messages". There is insufficient antecedent basis for this limitation in the claim.

13. Claims 48 recites "the time said message is created". There is insufficient antecedent basis for this limitation in the claim.

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14. Claims 50 recites "the attributes". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the part of a message recipient" is not clearly defined. It is unclear which part of the recipient is referred by the claimed limitation.

16. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "received ones of said messages" is not clearly defined. It is unclear the claimed "received ones" refers to "messages", "instructions", or others.

17. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "said sensors are selected from the list of temperature, time, internet,

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calendar, GPS". The temperature, time, and calendar are number representations of temperature, time, and date. The internet is either a protocol or a network. The GPS is a number representation of position. It is unclear how these number representations having a sensing function.

18. Claims 17, 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "means for converting any played message to a format controlled by said messaging system". It is unclear the claimed "controlled by" refers "converting.....controlled by" or "played message.....controlled by" or "a format controlled by" or others.

19. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "at least partially based on information obtained at said message playing time". It is unclear the claimed "at least partially based on information obtained at said message playing time" refers to "downloading" or "the identity". Also, it is unclear how a message playing time can be downloaded together with the identity at the time the message is played.

20. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "at least partially based on information obtained at said message

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playing time”. It is unclear the claimed “said playback is to said message sender”. The Examiner cannot understand this claimed limitation.

21. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “still video”. It is unclear the claimed “still video” refers to a “still picture” or “a paused video”.

Also, the phrase “video converted from audio”. It is unclear how audio can be converted from video.

22. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “repeat times” (line 2-3). It is unclear the claimed “repeat times” refers to different time schedule (for example, 2:30 pm, 9:40 am) or quantity of times (for example, one time, two times).

Also, the phrase “open mike times”. It is unclear what is the definition of such limitation.

Also, the phrase “identity of data to obtained”. The Examiner cannot understand such limitation.

23. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “a times” (line 2). It is unclear what is “a times”.

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24. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “at the time each said message is played” (line 7-8). It is unclear what is referred by this limitation.

25. Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “when at least a portion of said message is based on status information provided at the time said message is played” (line 7-8). It is unclear what is referred by this limitation.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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26. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “a clock for playing each received message” is not disclosed by the specification. The specification, for example, on item 10 Fig.1, a unit for displaying or playing the message. The clock itself does not play the message.

27. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “selection of said selected other message is controlled.....by information received by a message sender” is not disclosed by the specification. The specification, on section [0034], the message is controlled by information received from the sender.

28. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “additional message playing times for each said message” is not disclosed by the specification. Nowhere in the specification discloses that each message is provided with multiple times for playing.

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29. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “downloading together with said message playing time at least part of a message to be played” is not disclosed by the specification. Nowhere in the specification discloses downloading the message playing time together with at least part of a message.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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30. Claims 1-5, 8-34, 36, 37, 39-51 are rejected under 35 U.S.C 102(e) as being anticipated by Wood et al (US: 6816703).

For claims 1, 19, 28, 44, 47, Wood et al teach on column 3 line 61-63, a memory for storing personalized information (claimed “messages”) for playing at a predetermined time.

Wood et al teach on column 15 line 39-40, alarm clock for playing the personalized information.

Regarding claims 2, 34, Wood et al teach on column 3 line 63-67, the alarm sounds when the user is sleeping. Therefore, the message recipient did not perform any action for playing the message.

Regarding claim 3, see column 4 line 3.

Regarding claim 4, see column 7 line 39-41.

Regarding claim 5, see column 7 line 37-41.

Regarding claim 8, see column 2 line 28, a processor.

Wood et al teach on column 3 line 26-39, the retrieved message is not played. Instead, a customized message is presented based on the profile.

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Regarding claim 9, the profile is the claimed “information available at the time a received message is played”.

Regarding claim 10, Wood et al teach on column 4 line 65 to column 5 line 24, reminder message. The sender and the recipient are the same person. The profile is created by the user (sender/recipient). The customized message (claimed “selected other message”) is controlled by information received from the sender.

Regarding claims 11, 12, 30, 31, 41, Wood et al teach on column 3 line 25-39, the server computer retrieve and arrange personalized information and send it to the client computer via internet. The internet is the claimed “sensor”.

Regarding claim 13, Wood et al teach on column 3 line 37-39, a message is played continuously for a period of time.

Regarding claim 14, different messages must be stored at different memories (reads on claimed “messages are received by a plurality of memories”). Wood et al teach on column 10 line 22-24, different messages for different users.

Regarding claims 15, 26, 29, 36, 39, 42, 49, 50, Wood et al teach on column 4 line 3-9, depress a button to turn the alarm off (reads on claimed “override control for playing”).

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Regarding claims 16, 46, messages are stored at the server for downloading.

Regarding claims 17, 43, see column 8 line 22-25.

Regarding claims 18, 27, see column 5 line 1-24, the reminder is played at the recipient specific time category.

Regarding claim 20, see column 4 line 7-9, the same alarm message is played at different time (claimed “additional message playing times”) when the user neglects to turn off the alarm message.

Regarding claim 21, see column 5 line 1-2. Reminders messages (different messages) for holidays, birthdays, anniversaries, meetings (different playing times).

Regarding claims 22, 24, Wood et al teach on column 3 line 26-28, personalized information are downloaded to the client computer via internet. Wood et al teach on column 4 line 65 to column 5 line 23, personalized information includes schedule (claimed “playing time”) and message to be played.

Regarding claims 23, 25, Wood et al teach on column 7 line 8-23, the personal profile includes user preferences including subjects (claimed “identity”).

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Regarding claim 32, see column 7 line 35-41.

Regarding claim 33, Wood et al teach on column 5 line 9-12, designating only a day (claimed “duration of playback time”).

Regarding claim 37, all rejections as stated in claims 1 and 8 above apply.

Regarding claim 40, see column 5 line 9-12.

Regarding claim 45, see column 11 line 10-17.

Regarding claim 48, see column 9 line 24-27. the inserted scores of team 1 and team 2 are not available at the time the pre-recorded audio portion is created.

Regarding claim 51, see column 11 line 1-23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 6, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al as applied to claim 1 above.

Wood et al failed to teach “message contains a call-back number”. However, the message content is a “Decide Choice”.

Wood et al teach on column 2 line 37, transceivers (claimed “transmitter”).

Regarding “a response to a played message”, Wood et al teach on column 8 line 50-65, the user could log in and talk to other users via on-line chat. Whether the chat is a response to a played message is a “Decide Choice” depending on the content of played message and the content of on-line chat. Further, “Office Notice” is taken that using on-line chat to respond to a message is old and well known to one skilled in the art.

Wood et al teach on column 8 line 41-49, devices for input of the on-line chat (claimed “response”).

It would have been obvious to one skilled at the time the invention was made to modify Wood et al to have the “message contains a call-back number” and “a response to a played message” such that the modified system of Wood et al would be able to support the system users a convenient means of responding to the received messages.

32. Claims 7, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al as applied to claim 1 above.

Wood et al failed to teach “controlled play time is a plurality of different times”. However, the time to play the message is a “Decide Choice”. Further, “Official Notice” is taken

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that setting different time for playing messages as alarms is old and well known to one skilled in the art.

It would have been obvious to one skilled at the time the invention was made to modify Wood et al to have the “controlled play time is a plurality of different times” such that the modified system of Wood et al would be able to support the system users flexibilities of setting different time for playing the messages.

Conclusion

33. The prior art made of record and not replied upon is considered pertinent to applicant’s disclosure.

- Smith et al (US: 6463462) teach automated system and method for delivery of messages and processing of message responses

34. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

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Ming Chow



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